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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,392	04/09/2004	Darryl D. Amick	MOF 314	1591
23581	7590	09/13/2007	EXAMINER	
KOLISCH HARTWELL, P.C. 200 PACIFIC BUILDING 520 SW YAMHILL STREET PORTLAND, OR 97204			ZHU, WEIPING	
ART UNIT		PAPER NUMBER		
1742				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/821,392	AMICK, DARRYL D.
	Examiner Weiping Zhu	Art Unit 1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10 September 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 14-22 and 40-49 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 14-22 and 40-49 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 14-22 and 40-49 are currently under examination, wherein claim 18 has been amended and claims 40-49 have been newly added in applicant's amendment filed on July 5, 2007. The applicant has affirmed the provisional election of the Invention of II, claims 2, 8, 14-22, 24 and 34 without traverse and cancelled original claims 1-13 and 23-39 in the same amendment.

### ***Status of Previous Rejections***

2. The previous objections to claims 2, 8, 24 and 34 because of informalities and the previous rejections of claims 2, 8, 24 and 34 under 35 U.S.C. 103(a) as obvious over Amick (US 6,270,549) are withdrawn in light of applicant's amendments filed on July 5, 2007. The previous rejections of claims 14-22 on the ground of nonstatutory obviousness-type double patenting as stated in the Office action dated April 2, 2007 are maintained.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated

by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 14-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5, 8, 13 and 16 of copending Application No. 10/041,873 as stated in the Office action dated April 2, 2007.

With respect to the amended feature of claim 18, ('873) does not specify the compacting pressure, indicating the pressure can be optimized as desired. The zero pressure (i.e. non-compacted as claimed) is not excluded. Therefore, the claims of the ('873) meet the claimed limitation. Furthermore it is well held that discovering an

optimum value of a result-effective variable involves only routine skill in the art. In re Boesch, 617, F.2d 272, 205 USPQ 215 (CCPA 1980). In the instant case, the pressure is a result-effective variable, because it would directly affect the final density of the projectile. It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the pressure for the desired densities of the projectile. See MPEP 2144.05 II.

4. Claims 40-49 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 8, 9, 13, 16, 38, 48 and 49 of copending Application No. 10/041,873.

With respect to the newly added claims 40-49, the claims 1-5, 8, 9, 13, 16, 38, 48 and 49 of ('873) discloses a firearms cartridge comprising a casing, a primer, a propellant and at least one projectile having a density of at least 12 g/cc and being non-ferromagnetic. The projectile is formed by compressing a tungsten containing powder including a ferrotungsten powder. The projectile further includes a jacket and the ferrotungsten powder is placed into the jacket prior to the compressing step. Therefore, ('873) teaches the same firearm ammunition as claimed in the instant invention.

('873) does not specify the compressing pressure as claimed in the instant claims 40 and 45, however as discussed above the pressure is a result-effective variable, because it would directly affect the final density of the projectile. It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the pressure for the desired densities of the projectile. See MPEP 2144.05 II.

('873) does not specify the particle sizes as claimed in the instant claims 43, 47 and 49, indicating the particle size can be optimized as desired. Furthermore the particle size is also a result-effective variable, because it would directly affect the final density of the projectile. It would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the particle size for the desired densities of the projectile. See MPEP 2144.05 II.

('873) does not specify the projectile comprises a ferrotungsten-containing powder at least substantially comprising  $Fe_7W_6$  phase and BCC tungsten phase particles as claimed in the instant claim 48. However, it would have been obvious to one of ordinary skill in the art that the ferrotungsten-containing powder of ('873) would at least substantially comprises  $Fe_7W_6$  phase and BCC tungsten phase particles in order to make the projectile of ('873) non-magnetic as claimed in ('873), because  $Fe_7W_6$  phase and BCC tungsten phase are representative non-magnetic phases in a ferrotungsten powder which generally contains approximately equal percentages of magnetic and non-magnetic particles.

This is a provisional obviousness-type double patenting rejection.

***Response to Arguments***

5. The applicant's arguments filed on July 5, 2007 have been fully considered but they are not persuasive.

First, the applicant argues that ('873) was patented on May 15, 2007 renders the provisional obviousness-type double patenting rejection of the Office action dated April 2, 2007 moot. In response, the examiner notes that the issuance of ('873) as a patent

does not moot the provisional obviousness-type double patenting rejection. Only a valid declaration under 35 CFR 1.131 and/or 1.132 filed by the applicant could overcome the rejection.

Second, the applicant argues that the instant claims recite much less binder than the claim 1 of ('873). In response, the examiner notes that the ground of the rejection is based on that the claims of ('873) meet all the claimed limitations of the instant invention. ('873) may apparently include additional limitations in the claims.

Third, the applicant argues that ('873) fails to disclose or suggest forming at least a substantially portion of the projectile from a non-magnetic fraction of ferrotungsten-containing powder. In response, the examiner notes that ('873) claims in claim 13 that the bullet is not ferromagnetic (i.e. non-magnetic as claimed).

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WZ

9/10/2007

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